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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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04/06/2001

John Tree

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09/20/2006

O'BANION & RITCHEY LLP/ SONY ELECTRONICS, INC.
400 CAPITOL MALL
SUITE 1550
SACRAMENTO, CA 95814

EXAMINER

MENGISTU, AMARE

ART UNIT

PAPER NUMBER

2629

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/827,504	TREE, JOHN	
	Examiner	Art Unit	
	Amare Mengistu	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

Claim Rejections - 35 USC § 112

1. Claims 1-19,21-23,25,26-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following claims recitation does not have support in the specification as originally filed. The specification does not enable one of ordinary skill in the art at the time of filing how to make or use the following claims limitations.

The recitation of claim 1, “***an input unit for inputting data marks wherein each said data mark indicates a time and contents content that is broadcasted at said time***”

The recitation of claim 12, “***wherein said input unit includes a spring loaded button***”;

The claim recitation of 27, “***detecting a disconnection from said gateway device; and resetting said stored data marks***”;

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the limitation of claim 28, “**wherein the resetting step includes deleting the stored data marks**”, and;

2.

Thus, applicant's specification fails to enable one of ordinary skill in the art at time of filing to practice applicant' invention.

Claims 2-10,12-18,22-23,28-30 are rejected since they depend on rejected claims 1,21 and 26.

3. Claims 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed does not disclose the new recitation of claim 26 “**bookmarking the time of a broadcast within a data mark stored within a plurality of data mark**”.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “**an input unit for inputting data marks wherein each said data mark indicates a time and contents**”

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content that is broadcasted at said time” (claim 1), **“said display unit displays said indication of received data marks by illuminating said corresponding one or more of said plurality of display panels”** (claim 9), **“said data marks include information corresponding to a music file”** (claim 10); **“said information corresponding to said music file includes a text and an image information corresponding to said music file”** (claim 11); **“wherein said input unit includes a spring loaded button”** (claim 12,); **“input unit includes a music broadcast mark button and a television broadcast mark button”** (claim 13), **“said external device includes one or more of a personal computer, a personal digital assistant, a television set, a mobile telephone, a pager, and a wireless communication device “** (claim 16);” **said external device is configured to correspondingly display said received data marks on said external device”** (claim 17); **“said data marks are music marks corresponding to music files and further, wherein said data marks displayed on said external device includes information corresponding to said each received music marks”** (claim 18), **“said music marks displayed by said external device includes one or more of a title of the music corresponding to said each music marks, a name of the artist corresponding to each music marks, a title of the album corresponding to each music marks, and a graphical display of an album cover corresponding to each music marks”** (claim 19) , must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanmada et al (6,931,198).

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As to claim 26, **Hanmada et al.** discloses a method for detecting a connection (col.3, lines 45-53, col.4, lines 14-23, 39-44, fig.21 (F100, F101)); entering user account information (col.10, lines 20-29), transmitting stored data marks (col. 2, lines 11-16, col.3, lines 11-23, col.5, lines 1-23); receiving data corresponding to said data marks; and displaying said received data (col.5, lines 24-31, 50-67). It would have been obvious to one skill in the art to recognize that **Hanmada et al's** connection is to a gateway device (see, fig.8). Furthermore, gateway device is a functional unit that interconnects a local area network (LAN) with another or a computer attached to one or more network (see, fig. 1 (4) is the interconnections of the area network).

7. Claims 1-20,24,25,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Marks et al** (2002/0032019 A1) in view of **Yoshinobu et al** (5,686,954) and **Kelly et al** (5,907,322).

As to claims 1,20,32, **Marks et al** discloses an electronic data marker device, comprising: a display unit (see. Fig (CATEGORY...CHANNEL); and an input unit for inputting data marks wherein each said data mark indicates a time and contents content that is broadcasted at said time (Fig. 1 (rotatable dials), page 6 [0053], see, fig. 2 ("Minutes"), wherein said input unit is configures for connecting through an internet connection to retrieve text and/or image data associated with each said data mark ([0043],[0047]) said display unit is configured to receive said data marks from said input unit and correspondingly display said data marks on said of display panels (page 6

[0058], [0059]). **Marks et al** did not expressly detailed the display including a plurality of display panels. However, the patent of **Yoshinobu et al** is cited to teach that it is well known for an electronic data device to have a plurality of display panels (see, figs. (15, 18,19)).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to incorporate **Yoshinobu et al** system of having plurality of displays into the display system of **Marks et al** because this will allow the user to view multiple images at one time to save time.

Marks et al as modified by **Yoshinobu et al** does not expressly detailed having a mark button configured to bookmark broadcast material in response to interaction by a user. The patent of **Kelly et al** is clearly teaches that it is conventional for an electronic data mark device to have a mark button configured to bookmark broadcast material in response to interaction by a user (see, col.2, lines 41-55), establishing connectivity with a gateway device (see, fig. 2(60) "internet or other network"), transmitting and receiving information from the gateway (col.3, lines 29-50, col.4, lines 53-67).

Therefore it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use a bookmark button of **Kelly et al** into the input device of **Marks et al** because this will provide the user with a system for to easily retrieve and display the websites and website "hotlinks" associated with these bookmarked events (col.1, lines 46-51).

As to claim 2, **Marks et al** also discloses that the display unit includes one of a

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liquid crystal display, a cathode ray tube display, and a touchpad display unit ([0047], [0048]).

As to claim 3, **Yoshinobu et al** teaches that a base mounted to said display unit for vertically supporting said display unit (fig.9).

As to claim 4, **Yoshinobu et al** also teaches that each of said plurality of display panels on said display unit are non-overlapping (see, figs. 9,15).

As to claims 5,6,7 **Yoshinobu et al** further teaches that each of said plurality of panels have substantially the same dimensions/ a substantially uniform array/ a rectangular shape (see, figs. 9,15).

In regard to claim 8, **Yoshinobu et al** discloses said display unit is configured to selectively display an indication of said received data marks on a corresponding one or more of said plurality of display panels (fig.15)

As to claims 9,24,25 **Yoshinobu et al** also teaches that the display unit displays said indication of received data marks by illuminating said corresponding one or more of said plurality of display panels, date and time (see. Figs.15 (TOP 40'S), also 18 and 19).

As to claims 10,11, **Marks et al.** teaches that the data marks include information corresponding to a music file includes a text information corresponding to said music file (see. figs.1, 5-7). It is well known for an electronic device to have the a music file to includes an image information corresponding to said music file.

As to claims 12,13, **Marks et al.** discloses an input unit (fig.1 (rotary dials). It is obvious to rotary dial to include a spring and said input unit includes a music broadcast mark button and a television broadcast mark button (page 6 [{0053}, {0056}]) and said input is configured for entering the user's account information and performing necessary e-mark account access prior to retrieval of text and /or image data associated with each data mark ([0035], [0082]).

As to claims 14 and 15, **Marks et al.** also teaches that an output unit for coupling an external device (page 4 [0043]) and it is obvious for the output unit to have one or more of a USB port, a serial port, a parallel port, and an infra red (IR) port in order to be connected to PC or internet of wireless system.

As to claims 16,17,18 **Marks et al.** also discloses that the external device includes one or more of a personal computer, a personal digital assistant, a television set, a mobile telephone, a pager, and a wireless communication device and display said received data marks on said external device (page 4 [0043], page 6 [0056]).

In regard to claim 19, **Marks et al.** teaches that said music marks displayed by said external device includes one or more of a title of the music corresponding to said each music marks, a name of the artist corresponding to each music marks, a title of the album corresponding to each music marks, and a graphical display of an album cover corresponding to each music marks (see, [0024],[0029],[0043]).

Response to Arguments

8. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

As to applicant's argument in regard to USC 112 first rejection, the Examiner withdrew some of the 112 first rejections for some claims and maintained the rejection for the rest of the claims. Since the Applicant's argument was not persuasive and the Examiner couldn't find any support in the specification the 112 first rejections is maintained.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

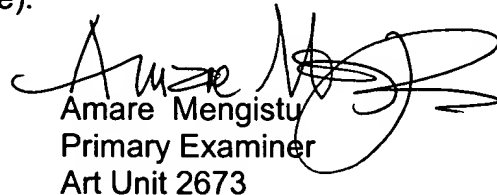
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (571) 272-7674. The examiner can normally be reached on M-F,T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3639. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Amare Mengistu
Primary Examiner
Art Unit 2673

AM

Sep. 17, 2006